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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/244,361 | 02/04/1999 | STEVEN CHOW | 4103-26421 | 3662 |

7590 07/16/2002

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|------------------------------|---|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/244,361 | CHOW ET AL. | |
| | Examiner Steven HD Nguyen | Art Unit 2665 | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | | |
| Period for Reply | | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>04 February 1999</u> . | | | |
| 2a) <input type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final. | | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | |
| Disposition of Claims | | | |
| 4) <input type="checkbox"/> Claim(s) _____ is/are pending in the application. | | | |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration. | | | |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. | | | |
| 6) <input type="checkbox"/> Claim(s) _____ is/are rejected. | | | |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. | | | |
| 8) <input checked="" type="checkbox"/> Claim(s) <u>1-29</u> are subject to restriction and/or election requirement. | | | |
| Application Papers | | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. | | | |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. | | | |
| If approved, corrected drawings are required in reply to this Office action. | | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | |
| 13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | |
| a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: | | | |
| 1. <input type="checkbox"/> Certified copies of the priority documents have been received. | | | |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. | | | |
| 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). | | | |
| * See the attached detailed Office action for a list of the certified copies not received. | | | |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). | | | |
| a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | | |
| 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | | |
| Attachment(s) | | | |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | | 6) <input type="checkbox"/> Other: _____ | |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18 and 20-28, drawn to a method and apparatus for multiplexing a synchronous stream and a asynchronous stream on an output stream, classified in class 370, subclass 537.
 - II. Claims 19 and 29, drawn to a method and apparatus for determining a ratio of between the input signals and using even and odd time slot for transmitting the signals, classified in class 370, subclass 252.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I does not require a step of determining the ratio of the input signal and using even and odd time slot for transmitting data as Group II. The subcombination has separate utility such as determining the ratio of the input signal and using even and odd time slot for transmitting data.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is

proper.

5. Because these inventions are distinct for the reasons given above and have acquired a

separate status in the art because of their recognized divergent subject matter, restriction for

examination purposes as indicated is proper.

6. A telephone call was made to Mr. Christopher Palermo Reg # 42056 on 7/8/2002 to

request an oral election to the above restriction requirement, but did not result in an election

being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR

1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR

1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Steven HD Nguyen
Primary Examiner
Art Unit 2665
July 14, 2002